

## REMARKS

This is a response to Office Action dated 6/29/2001, and follows the same sequence, with paragraph numbering matching the Office Action.

1. A new reissue declaration is supplied, It identifies the error of failure to claim the absence of the boiling step,
2. . A new reissue declaration is supplied, It contains a statement that all errors which are being corrected in the reissue application up to the time of filing of the declaration arose without any deceptive intention on the part of the applicants.
3. Claims 1-7 stand rejected as being based upon a defective reissue declaration.

This has been corrected as discussed above in paragraphs 1 and 2.

4. Counsel apologizes for the lack of the corrected declarations. Corrections are supplied along with this response.
5. Claims 1-3 stand rejected as being broadened outside the two-year statutory period. It is believed that the filing, with certification, by express mail on June 1, 2000 falls within the two-year period, but this is not necessary to save

these claims. This will be further discussed in paragraph 6. Claims 1-3 are not broadened, for the following reasons: Claim 1, and its dependent claim, Claim 2, originally stated "...proofing said second-rise bagel dough individual bun portions in a warm environment for a third period of time of approximately three hours, said third period of time is greater than the sum of rise times in steps c and e to form English muffin bagel dough individual bun portions..." This was slightly non-grammatical. There was an intent to simplify in changing to "...proofing said second-rise bagel dough individual bun portions in a warm environment for a [third period of] proof time [of approximately three hours, said third period of time is] much greater than the sum of rise times in steps c and e to form English muffin bagel dough individual bun portions..." This removed the term "approximately" and was thought to make the claim more succinct by making the relative proofing time "...much greater than the sum of rise times in steps c and e..." The Examiner is asked to reconsider this change and reinstate it by refusing entry of the change to Claim 1, made by amendment in this response, back to the exact wording of clause f) of the original patent. Claim 3 similarly is amended in this response to return it to the exact wording of the original Claim 3. It similarly attempts to eliminate the "approximately," and in fact is less broad (or perhaps identically broad) in that it specifies "maximum rising" without

the approximate time. ..." The Examiner is asked to reconsider this change and reinstate it by refusing entry of the change to Claim 3, made by amendment in this response, back to the exact wording of clause "f)" of the original patent.

6. Applicants have claimed the benefit of filing by Express Mail on June 1, 2000, one day before the end of the two-year period for broadening by reissue.

This claim is being furthered by petition, even though, as discussed above, applicants do not believe that they are broadening the claims.

7. Claims 1-4 stand rejected as based upon new matter. Counsel added the discussion in an attempt to put prior art into context – in the prior art section of the patent. Prior art, once admitted to be prior art, should not be a problem unless its position in the text is confusing, and unless there is an attempt to base patentability of a claim on the prior art. The prior art discussion added on page 2 to line 13 of page 3 was intended to increase understanding, not intended to add confusion. Accordingly, it has been canceled. This is also the situation with respect to the amendment on lines 22-25 on page 6 and lines 2-10 and 13-16 on page 7. All of this material, admittedly a discussion of prior art, and believed to be true and helpful, has been canceled. Where

appropriate, small changes have been place by amendment, to reinstate the exact wording of the original patent.

8. This paragraph of the Office Action places an objection under section 132 coextensive with the rejection in paragraph 7. All the text subject to objection has been canceled by amendment in this response.
9. This paragraph responded to counsel's contention that text added as admitted prior art is not new matter. The Examiner was not convinced; all the text objected to has been canceled.
10. Claims 1-4 and 8 stand rejected under section 112 "...as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner is asked to reconsider this. The Declaration of Robert Brown clearly states that he had possession of the invention, that he had made English muffin bagels according to the specification, and that he, as a person skilled in the art and as a person knowing others skilled in the art, could make English muffin bagels by following the recipe in the patent. The limitations of

"omitting any partial baking step on any isolating planks on the deck of a commercial oven' and of "a high-rise, light, English muffin bagel..." have been canceled. [Note that the isolating plank is related to the boiling step, and is not necessary or even desirable in baking the English muffin bagel. The original patent specification was quite specific about the elimination of the boiling step. [See Abstract of the Disclosure, line 5. See Column 2, lines 45-47.]

11. The Examiner is thanked for accepting the limitation "omitting any boiling step." As to the use of the term "deck," this term has been canceled throughout this reissue patent application. The term deck continues to be in common use in commercial baking to describe the moving shelf in a commercial baking oven upon which goods are placed for baking. All mentions of the isolating plank have been canceled.

12. Claims are presented in clean claim form and in bracket/underline form in this response.

13. Claims 1-4 and 8 stand rejected under section 112 as being indefinite. Claim 1 has been corrected. "Kneading" is now properly spelled. Step f has been amended to use the term "greater" without the comparative "much." Claim 3 preamble has been returned to the exact wording of the original patent, which provides a basis for bagel dough and the quantity of yeast nutrients. The terms

“dough” and “said dough” have been introduced in claim 3, along with the term “selected shapes,” duplicating as much as possible the full preamble and terminology of Claim 3 of the original patent. Claim 3 no longer has the term “very” in “...a very long proofing step in which maximum rising for the yeast nutrients present is approached...”

Counsel does not believe that this repeats the rejection of Claims 1-7 (plus 8) according to paragraph 5 of the Office Action dated 11/15/00 “...as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” Counsel contests this ground of rejection. The inventors had full understanding of the invention, and had made several successful tests without any failure tests. The Examiner is asked to give particulars if the following explanation should not suffice.

The limitation of “omitting any boiling step” indeed was not in the claims of the original patent, and is identified as the primary reason for the filing of this reissue application. Omitting any boiling step was very well understood by the inventors, as evidenced by the Declaration of Robert W. Brown, filed with this response, and the Declaration of Bruce A. Kade, also filed with this response. Omitting the boiling step was also emphasized in the written description of the original patent, Column 2 , lines 45-46. “Divergence continues. Standard bagels are boiled and simmered in water! FIG.

2 shows the boiling step as step (A) for H<sub>2</sub>O.” [ There is an error in the patent Column 2, line 47. FIG. 2 shows the boiling step as ‘H’ – not “A.”]

The partial baking step on isolating planks was standard practice in commercial bagel baking at the time the original patent was filed, and is still the standard practice. This is stated in the Declaration of Robert W. Brown, filed with this response. Standard practice is to take the bagels out of the boiling kettle and place the wet bagels on an isolating plank. There is no discussion of isolating planks in the original patent application, but since the isolating planks are an integral part of the standard bagel boiling step, there was no intent to change the process – which never had included any isolating planks. All references to isolating planks, including all references negating the use of isolating planks, have been eliminated.

The Examiner is asked to withdraw all Section 112 (first and second paragraph) objections. The inventors knew what they had invented in the English Muffin bagel. They told how to make such bagels, by not boiling, and by a very long rising step instead. They told why this would be important – “...it looks much like a standard bagel, except that it has the inside texture of the English muffin, with nooks and crannies instead of the smooth texture of the standard bagel ... cornmeal coating ... doughnut shape of the standard bagel except ... navel ...bite mark ... nooks and crannies ...”

14. The Examiner maintains without explanation the Section 112 (second paragraph) rejection "...as previously cited in the last office action ..." plus claim 8 by amendment. Counsel believes that this repeats the objections in Paragraph 7 of the 11/15/00 Office Action, an indefiniteness objection.

The misspelling of "kneading" has been corrected.

The Examiner is asked to reconsider the scope of the claim as determined by "much greater." First of all, yeast rising times are subject to a number of variables, involving time, temperature, nutrients, moisture, amount and variety of yeast present, whether yeast, sugar and water have been pre-mixed to cause increase in the number of yeast cells, thoroughness of mixing, and whether yeast inhibitors such as cinnamon are present. Bakers, both amateur and professional, are aware that rising times of yeast breads are variable, and subject to environment. The term "much greater," in the context of yeast rising times, is not indefinite. Further, the term is not simply "much greater" but is "much greater than the sum of rise times in steps c and e" in Claim 1.

Claim 3 provides "...a very long proofing step in which maximum rising for the yeast nutrients present is approached." This is certain. As the yeast nutrients are used up, rising stops as the yeast cells starve. Claim 8 also specifies such maximum rising, "...resulting generally in the bagels expanding beyond standard

bagel rising, partially closing the navel, and touching adjacent bagels to form bite marks.”

Claim 4 specifies a very long proofing step which “takes 3 hours.”

15-16 Paragraphs 15 and 16 establish the law of obviousness as set forth in Section 103(a) and require no response.

17. Paragraph 17 rejects Claims 1-4 and 8 under Section 103(a) over the recipe for English muffins in the Boston Globe. The Examiner is asked to reconsider. There are tremendous differences between an English muffin recipe and the English muffin bagel recipe and process pointed out in this patent application.

The Examiner identifies the first difference at the very beginning, -- “...mixing the ingredients to form a thick batter...” A batter is not a bagel-dough mix.

The Examiner trivializes the making of yeast-risen items generally, and English muffins particularly, by giving the recipe “mixing a batter, letting the batter rise, stirring the batter down and letting it rise again.” There is much more to making English muffins than that. The Boston Globe recipe, for English muffins, includes instant mashed potatoes, 2 to 3 tablespoons softened butter and a total of 1 1/4 plus three tablespoons water. It specifies “...a smooth, loose, thick batter, heavier than the usual pancake batter but not at all like conventional dough...let rise, about 1 1/2 hours – it must be bubbly, however long it takes.” The English muffins are cooked slowly, in rings buttered fairly

generously, until bubbles pierce the top surface ... dryish gray color ... this will take 6 to 8 minutes or more ... Now turn muffins over for a brief cooking on the other side."

Following the recipe for an English muffin in the Boston Globe will result in a standard English muffin, NOT AN ENGLISH MUFFIN BAGEL

The Examiner trivializes the English muffin bagel by stating "The newspaper also discloses a recipe for a bagel." The bagel recipe in the Boston Globe is given full treatment to differentiate the bagel from the English muffin. The Globe recipe requires that the bagels, once formed into a ring shape, be let to rise for about 30 minutes and then be broiled for about two minutes on each side, AND THEN BE SIMMERED FOR ABOUT TWO MINUTES ON EACH SIDE! Following the recipe for a bagel in the Boston Globe will result in a standard bagel, NOT AN ENGLISH MUFFIN BAGEL..

There is no hint anywhere that anyone should attempt to merge or concatenate the recipes for English muffin and for bagel. The Boston Globe sets the scene in the article as follows:

"Take the bagel. It's shaped like a doughnut but is boiled before baking. Chewy rather than light, bagels are unsweetened breads traditionally served with a generous dose of cream cheese, an, if you're lucky, lox. They're delicious hot from the oven."

[The Article next contains a short paragraph discussing pita bread.]

Then there's the English muffin, an American favorite most often served at breakfast. Although commercially prepared variety is good and easy to find, nothing

beats the flavor of homemade English muffins, served hot with loads of sweet butter. A little jam isn't a bad idea, either."

The Boston Globe article makes a clear distinction between the bagel and the English muffin. It provides a separate recipe for bagels and a separate recipe for English muffins. There is no hint that these two items could be made from similar dough, much less that an English muffin bagel could be made from bagel dough. The doughs are quite different. The bagel recipe in The Boston Globe specifies two kinds of flour, bread flour and ground oat flour. The flour totals 3 to 3 1/4 cups; the water totals 1 1/2 cups. This is a >2:1 flour/water ratio. The English muffin recipe in The Boston Globe specifies one kind of flour, all-purpose flour, but adds 2 tablespoons instant mashed potatoes. It also adds softened butter. Total flour/including potatoes,, is less than 2 3/4 cups; total water is slightly more than 1 1/4 cups. The recipe states that, when beaten vigorously, this makes"...a smooth, loose, thick batter, heavier than the usual pancake batter but not at all like conventional dough."

In summary, The Boston Globe makes clear the distinction between Bagels, Pita Bread and English muffins, and tells how to make each of these items, with a separate list of ingredients and a separate procedure for each. The English muffin is different from the bagel and from Pita bread. The English muffin bagel of this patent application is different from both the English muffin and the bagel.

The Examiner is asked to withdraw the comment "The sitting of the batter after the second rising is equivalent to the claimed long proofing step." The second rising step in The Boston Globe recipe for English muffins, is stated to be: "...Cover with plastic wrap and let rise, preferably at around 90 degrees, until batter has risen and large bubbles have appeared in the surface (usually about 1 1/2 hours – it must be bubbly, however long it takes)." The statement that the batter may sit merely gives the option of keeping the batter for a while, possibly until the diners arrive ready to eat. This is common in the case of pancake batter, which also may be kept for a time prior to cooking the pancakes. Under any circumstances, rising time for English muffins is not to be confused with rising time for bagels or, for that matter, rising time for bread generally. It is not possible to achieve English muffin bagels by following the English muffin recipe in the Boston Globe. The batter is different. The baking is different. The baker might end with an English muffin with a hole in it, but not with an English muffin bagel..

The Examiner is asked to withdraw the comment that "the claims do not define what the ingredients are. " While this comment is technically true, it gives the wrong impression. The claims state "...bagel ingredients." No baker, amateur or professional, would have any trouble determining bagel ingredients. A typical set of bagel ingredients appears at Column 2, lines 25-34 in the original patent; another set of bagel ingredients appears in the Boston Globe article.

The Examiner is asked to withdraw the comment about the similarity of bagel ingredients and English muffin ingredients. The Boston Globe article shows different flours, all-purpose flour, bread flour and ground oat flour; different amounts of yeast, and different amounts of water. The Boston Globe article also shows different ingredients as follows:

sugar in the bagel recipe;

beaten egg in the bagel recipe

instant mashed potatoes in English muffins recipe;

softened butter in the English muffins recipe.

The Examiner is asked to withdraw the comment about the cornmeal coating. While it is common to use cornmeal as a non-stick coating on the bottom of a bagel, it is not at all common to coat the bagel top surface with cornmeal. Sesame seeds, poppy seeds, onions – these are common coatings for bagels, not cornmeal.

The Examiner is asked to reconsider the comments with regard to Claim 6. A traditional bagel is toroidal, with a circular cross section through the outside ring. The English muffin bagel presents a cross-section which is taller than wide through the outside ring. The partially closed navel is easy to see and is described in common terms.

The Examiner's comment about size are correct, but size is not depended upon to differentiate novelty or utility in the claims. Applicants concede that it would be obvious to vary the size.

The Examiner commented "As to the kiss marks, this does not make the bagel to be different. ,It will inherently happen whenever any baked product is placed close ..." This comment is true, but it is also true that the traditional bagel should not have bite marks. During recent years, as the traditional bagel has increased in bulk, bite marks have become more common as the bagels are crowded during processing and baking. Claims 6 and 7 have accordingly been canceled..

The Examiner is asked to reconsider the comments in this paragraph and withdraw any related rejection. The following statements are true:

1. The bagel and the muffin have long been recognized as different, with different Configurations
2. Yeast-risen items do not rise identically when sitting as when proofing. Proofing normally requires warmth, to activate the yeast.
3. English muffins are not boiled. Traditional bagels are boiled.
4. Bagel and muffin are different products. The English muffin is different from traditional muffins. The English muffin bagel is different from bagel, muffin and English muffin.
5. A great number of baked items have, as their main ingredients, flour and yeast.

The Examiner is asked to withdraw the comments in Paragraph 18. There are thousands of yeast-risen breads, each having as important ingredients flour and yeast. Such items include breads, rolls, bagels, muffins, and a great number of other items. There are also a great number of baking-powder breads and a great number of unleavened breads. Many of the yeast-risen breads have multiple steps of kneading and rising.. There is no boiling step for most of these items, but there is a boiling step for the traditional bagel.

In summary, applicants have shown how to take common bagel dough, following the recipe by combining ingredients and following procedures for making traditional bagels – up to but not including the boiling step – but then changing procedures to follow the long proofing step and baking to form a very different item, the English muffin bagel. As stated in Column 1, lines 6, it “...relates to a specialty bun which is configured like a standard bagel, which has the nook-and-cranny texture of the standard English muffin, which is intermediate in chewability between the standard English muffin and the standard bagel, and which toasts and tastes very like the standard English muffin.’

19. The Examiner is asked to reconsider the arguments filed February 20, 2001. In particular, the Examiner is asked to reconsider the essential differences between a bagel and an English muffin and accept that “mixed bagel dough ingredients” is

acceptable to define the starting point in the claims. These are fully identified in the original specification; these are fully understandable to those who bake bagels, whether amateur or professional.

20. The Examiner states the procedures and time limits for response. This response is filed within all time limits. Applicants respectfully request an opportunity to meet with the Examiner to resolve all issues. Counsel will telephone to arrange a date for the personal interview.

Robert W. Brown & Bruce A. Kade

By Carl C. Kling

Carl C. Kling, (Reg. 19, 137)

1. (Amended) A method of preparing bagel ingredients to form an English muffin bagel,

characterized by:

- a) mixing a bagel-dough mix;
- b) kneading said bagel-dough mix;
- c) letting said bagel-dough mix rise in a warm environment to form first-rise bagel dough;
- d) shaping said first-rise bagel dough into individual bun portions;
- e) letting said bagel-dough individual bun portions rise in a warm environment to form second-rise bagel dough individual bun portions;
- f) proofing said second-rise bagel dough individual bun portions in a warm environment for a proof time [much] greater than the sum of rise times in steps c and e to form English muffin bagel dough individual bun portions;
- g) omitting any boiling step [and omitting any partial baking step on any isolating planks on the deck of a commercial oven]; and
- h) [deck] baking said English muffin bagel dough individual bun portions to form completed English muffin bagels.

Appendix Showing Changes

2. (Amended) A method of preparing bagel ingredients to form English muffin bagels, according to Claim 1, in which step (][h) is preceded by an intermediate step (f.1) of water-misting, and coating top and bottom surfaces of said English muffin bagel individual bun portions with a thin layer of cornmeal.

3. (Amended) A method of preparing mixed bagel dough ingredients to form English muffin bagels,

characterized by

- a) a first rising step;
- b) a second rising step;
- c) any boiling step is omitted;
- d) a [very] long proofing step in which maximum rising for the yeast nutrients present is approached; and
- e) a baking step, resulting in an English muffin bagel.

4. A method of preparing bagel ingredients to form English muffin bagels according to Claim 3, in which said [very] long proofing step takes 3 hours.

8. (Amended) An English muffin bagel prepared from mixed bagel dough ingredients by the process characterized by:
- a) a first rising step;
  - b) a second rising step;
  - c) a [very] long proofing step in which maximum rising for the yeast nutrients present is approached, resulting generally in the bagels expanding beyond standard bagel rising, partially closing the navel, and touching adjacent bagels to form [kiss] bite marks;
  - d) omitting any boiling step [and any partial baking step on any isolating plank,];  
and
  - e) a baking step;
  - f) resulting in an [light] English muffin bagel of texture intermediate the standard bagel and the standard English muffin.